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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/691,038	10/21/2003	Peter G. Webb	10990641-2	7535

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AGILENT TECHNOLOGIES INC.

INTELLECTUAL PROPERTY ADMINISTRATION,LEGAL DEPT.

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EXAMINER

LIN, JERRY

ART UNIT

PAPER NUMBER

1631

NOTIFICATION DATE

DELIVERY MODE

02/06/2009

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

IPOPS.LEGAL@agilent.com

Office Action Summary

Application No.

10/691,038

Applicant(s)

WEBB ET AL.

Examiner

JERRY LIN

Art Unit

1631

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 November 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 21-48 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 21-24 and 26-48 is/are rejected.
- 7) ☒ Claim(s) 25 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-8508)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. Applicants' arguments, filed 11/17/08, have been fully considered and they are deemed to be persuasive in-part. The following rejections and/or objections are either reiterated or newly applied. They constitute the complete set presently being applied to the instant application.

Status of the Claims

Claims 21- 48 are under examination.

Claim Rejections - 35 USC § 101

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. Claims 21-24, 26-37, 39-48 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

While claims 21-24, 26-37, 39, 40, 42-44, and 46-48 are drawn to an apparatus or a computer program, the apparatus or computer program are embodiments of a computational method. Thus instant claims are drawn to a process involving the judicial exception of a computational algorithm. Claims drawn to a judicial exception is non-statutory unless the claims include a practical application of that judicial exception as evidenced by a physical transformation of matter, or if the claimed invention recites a useful, tangible and concrete final result. In the instant claims, there is no physical

transformation by the claimed invention, thus the Examiner must determine if the instant claims produce a useful, tangible, and concrete final result. See MPEP 2106.

Claims 21-24, 26-37, 39, 40, 42-44, and 46-48 do not produce a useful, concrete, and tangible final result. A useful, concrete, and tangible final result requirement requires that the claim must set forth a practical application of the mathematical algorithm to produce a real-world result. The instant claims are drawn to an apparatus that performs a method that derives a corrected drive pattern upon sensing an error. However, deriving a corrected drive pattern does not necessarily require a tangible result. Rather, deriving a corrected drive pattern only requires the processor manipulate data. Thus the instant claims do not require that a tangible result must be produced. Examples of amendments to overcome this rejection include amending the claims to identify/recite a concrete result and to recite that the result is outputted to a display or to a user or outputted in a user readable format. However, applicant is reminded that any amendment must be fully supported and enabled by the originally filed disclosure.

Claims 40-45 are drawn to a computer program product which comprises a computer readable storage medium. Interpreting broadly, a computer readable storage medium may encompass carrier waves or electromagnetic signals, which are non-statutory *per se*. Thus, the instant claims are non-statutory.

Response to Arguments

4. Applicants have responded to this rejection by stating that claims 21-24, 26-37, 39 and 46-48, include a processor and sensor and thus are statutory. However, the

instant claims are embodiments of a computational method. As such an embodiment, the method still requires a practical application. In the instant case, the processor create a corrected drive pattern, but this pattern is not necessarily used to operate the apparatus for fabricating or is not communicated to outside world. Thus instant claims 21-24, 26-37, 39, and 46-48 are non-statutory.

Applicants also state that claims 40-45 are drawn to a computer program product which comprises a computer readable storage medium. Interpreting broadly, a computer readable storage medium may encompass carrier waves or electromagnetic signals, which are non-statutory *per se*. Thus, the instant claims are non-statutory.

Claim 38 is drawn to an apparatus and not an embodiment of a computational method. The rejection is withdrawn as it is directed to claim 38

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

6. Claim 38 is rejected under 35 U.S.C. 102(a) as being anticipated by Blanchard (WO 98/41531).

Blanchard teaches an apparatus with a dispensing head and a transport system (page 56, line 24-page 57, line 24), wherein the drive pattern controls the operation of the transport system (page 57, lines 3-5), and the operating parameter is the position of

the substrate or dispensing head and the sensor views the substrate or dispensing head (pages 62-64; pages 75-76).

Withdrawn Rejections

7. Applicant's arguments and amendments, filed 11/17/08, with respect to the rejection made under 35 U.S.C. §103 and §112, 2nd paragraph have been fully considered and are persuasive. The reference of Gutamann et al. is not available as prior art. The amendment was sufficient to overcome the rejection under §112, 2nd Paragraph. These rejections have been withdrawn.

Allowable Subject Matter

8. Claims 25 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JERRY LIN whose telephone number is (571)272-2561. The examiner can normally be reached on 7:00-5:30pm, M-TH.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Marjorie A. Moran can be reached on (571) 272-0720. The fax phone

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number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Jerry Lin/
Examiner, Art Unit 1631
2/2/09